II. Remarks

To highlight the distinction of the above-referenced invention over the prior art as interpreted by the Examiner in the Office Action of August 8, 2008, Paper No. 20080801, the claims were amended as set forth herein. Independent Claim 1 was amended to more clearly define the subject matter of the invention and to place all of the claims remaining in the application in condition for allowance. No new matter was presented and such amendments are deemed unobjectionable. Entry thereof is respectfully requested.

In the above Office Action, the Examiner rejected Claims 1, 2, 5, 7, 10, 12, 15, 17, and 21 under 35 U.S.C §103 as being unpatentable over the teachings of Dahl, U.S. Patent No. 2,820,256 taken in combination with the teachings of Tegg et al., U.S. Patent No. 4,744,111. Further, the Examiner rejected Claims 3, 8 and 13 under 35 U.S.C. §103(a) as being unpatentable over the teachings of Dahl in view of Tegg et al., and further in view of the teachings of Braxton; U.S. Patent No. 4,380,836.

Applicant's attorney respectfully traverses each of the 35 U.S.C. §103 rejections set forth herein in view of the claims as currently amended and for the reason that Applicant's invention is not an obvious improvement over the prior art.

With respect to the rejections under 35 U.S.C. §103, it is noted in MPEP §706 that the standard of patentability to be followed in the examination of a patent application is that which was enunciated by the Supreme Court in *Graham v. John Deere*, 148 USPQ 459 (1966), where the Court stated:

> "Under Section 103, the scope and the content of the prior art are to be determined; differences between the prior art and the claims

> at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved."

Accordingly, to establish a prima facie case of obviousness, the Patent Office must: (1) set forth the differences in the claim over the applied references; (2) set forth the proposed modification of the references which would be necessary to arrive at the claimed subject matter; and (3) explain why the proposed modifications would be obvious. To satisfy step (3) above, the Patent Office must identify where the prior art provides a motivating suggestion, inference or implication to make the modifications proposed in step (2) above. *In re Jones*, 21 USPQ2d 1941(Fed. Cir. 1992).

The mere fact that the prior art may be modified by the Examiner does not make the modification obvious unless the prior art suggests the desirability for the modification. *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992). In the present case, the Examiner has failed to make a proper prima facie showing of obviousness since the Examiner has failed to show how the prior art suggests the desirability of the proposed modification.

Mere identification in the prior art of each element of the claimed invention is insufficient to defeat the patentability of combined subject matter as a whole. The Office Action must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. The Office Action fails to set forth a *prima facie* case of obviousness. In order to establish a prima facie case of obviousness according to MPEP §706.02(j), the cited references must teach or suggest all of Applicant's claim limitations, and there must be some suggestion to modify a reference or to combine teachings of each of the references.

The unobviousness of the present invention over the cited reference will become clear upon considering each of the problems that the prior art is directed to and the specific teachings each propose in order to solve this problem:

Dahl is directed to the general problem of providing a lightweight enclosure that may be readily erected and/or collapsed into compact form to overcome the lack of ease of transportability of temporary toilet shelters by individuals in an automobile. To solve this problem, Dahl proposes a light weight enclosure, to be used by an individual which is of rugged construction and may be readily erected and collapsed into compact portable form for transportation in an automobile from one site to another. The structure consists of four upright side walls each including a pair of wall sections on opposite sides of a central foldable dividing line that extend transversely around the enclosure. The side walls are foldable relative to each other along their longitudinal edges and the wall sections are foldable along the central foldable dividing line to form a compact stack of eight wall sections with the hinge strip 40 attached to wall sections 26 and 30 to enclose the remaining six wall sections to provide a lightweight stack to be carried by an individual. Such a stack, according to the specific teachings of Dahl, is light enough and small enough to be carried in a passenger automobile trunk and therefore may serve for family use as well as industrial use. Two adjacent sections of two adjacent side walls are detachable with respect to one another and are respectively at opposite sides of the stack and are interconnected by a double hinge of a width sufficient to extend across the thickness of six intermediate wall sections of the stack. The remaining wall sections are interconnected by transverse hinges. In the preferred practice of the invention, the enclosure has a doorway on one of its four sides and a permanently hinged door for the doorway which is made in two sections

lying on opposite sides of the central foldable dividing line to permit the desired collapse of the structure into the eight layer stack. Dahl teaches that it is highly desirable to have all eight of the wall sections interconnected to provide insurance against any section becoming separated, misplaced or lost. Such interconnection is also desirable to maintain the desired relationship among the various sections to prevent confusion that may be called by one section being inadvertently moved out of its normal place in the eight-section assembly. In the final step of the folding arrangement, as shown in Figure 3, the wall sections are folded down on itself using a hinge trip 40 thereby forming a stack of eight of the wall sections. It is apparent in this final folded state of the structure as taught by Dahl that the double inch strip 40 is relatively wide to provide a web 55 of substantial width to unify the stack since it cooperates with the wall sections 26 and 32 enclosing the remaining six wall sections.

As pointed out by the Examiner, Figure 2 shows a step in the process of making an eight-layer stack where the enclosure is collapsed to a flat state. As clearly set forth in the teachings of Dahl according to the preferred practice, this is not a transportable state nor is this a transportable planar state since Dahl clearly teaches at column 4, lines 13-38 that Figure 2 is only the first step in folding the structure for transportation purposes. This first step, by itself, cannot accomplish the teachings as a whole or the objectives of the complete reference. Dahl teaches a second, as well as, a final step of forming a stack of eight of the wall sections and a double hinge strip 40 unifies the stack to enclose the remaining wall sections in order to attain his objectives of the preferred practice. The final transportable stack of eight sections permanently connected together in such a manner as to permit the sections to be stacked for transportation by an individual in the trunk of an automobile or to be unfolded for erection of the enclosure is taught at column 1, lines

51-55. The teachings of a transportable stack of eight sections are contrary to Applicant's teachings of a two layer stack and therefore could not possibly motivate a person skilled in the art to use Dahl's teaching in an attempt to obviate Applicant's invention since the first step teachings, by itself, do not accomplish the objective of Dahl, and indeed is contrary to Dahl when considering the objectives of Dahl.

Tegg et al., U.S. Patent No. 4,744,111, is directed to problems associated with portable toilet structures for outdoor concerts, athletic events, and the like. These portable units are cumbersome and must be transported in the assembled condition thereby limiting the number of units that may be transported by a carrier. Prior art knock down units have been proposed to permit a larger number of units to be transported on each carrier but disassembly and reassembly of these units is usually a time consuming operation. To solve this problem, Tegg et al. teaches a portable knock down toilet structure, which is readily assembleable into a complete unit, simple and inexpensive. The vertical walls are provided with slots in the edges thereof and U-shaped clamping members having pins which engage in the slots are utilized so that each clamping member releasably clamps the edges of the pair of adjacent walls. Further, the lower edges of portions of the vertical walls are provided with slots for quick releasable engagement with clips secured to the base to permit ready attachment and detachment of vertical walls to the base. The top wall is releaseably secured to the vertical walls by cam locks mounted on the vertical walls and engageable with the slots in the top wall. With this arrangement, a single operator may readily assemble and disassemble a plurality of the toilet structures only in a matter of minutes. Because of the construction of various components, the components may be stacked on a carrier vehicle individually to permit the transport of a large number of units, while minimizing the

space requirements. For example, the side walls and rear walls may be placed in a single stack, and the front walls with the attached doors may be placed in another. The base may be arranged in stacked relation, and the holding tank and other units may be arranged together. Damaged components such as a damaged vertical wall may be readily replaced without requiring replacement of the entire unit.

Applicant's invention is directed to problems associated with his earlier portable prior art toilet shelter disclosed in U.S. Patent No. 4,380,386, which is significantly more cumbersome to stack and fold for transporting as well as much more costly than the collapsible enclosure as taught in the present invention. To solve this problem, Applicant teaches a portable toilet shelter including a loop enclosure that is mountable to a base, and is adapted to receive a roof. The loop enclosure includes planar opposed end walls each having opposed longitudinally oriented edges. Opposed planar side walls are positioned between the opposed planar end walls, with each of the planar side walls having opposed longitudinally oriented edges. Flexible hinges connect the edges of the planar side walls to respective adjacent edges of the planar end walls to complete the loop enclosure. To dismantle the portable toilet, the loop enclosure is lifted away from the base and placed on its side permitting it to automatically fold flat on the ground to a double thickness layer, as depicted in Figures 8 and 9 of the application. When the loop enclosure is placed on its side and permitted to collapse, the planar front and planar back end walls fold relatively towards their respective planar side walls. In other words, the walls collapse towards one another such that the inside surface of the planar front end wall overlays one of the inside surfaces of one of the planar side walls, while the inside surface of the planar back end wall overlays the other of the inside surfaces of the planar side walls. Additionally and alternatively, the collapsed portable

toilet shelter, the roof and floor can be individually collapsed and folded together for transportation with the loop enclosure. Once the loop enclosure is set aside or loaded on a truck in its stackable condition, the empty toilet unit is removed from the base and loaded to a truck and the base is then lifted from the ground and loaded to the truck. Accordingly, the compact collapsed loop enclosure can be stacked in any convenient optimized manner to maximize the number of units transportable by a truck which has been twice the number of foldable shelters as disclosed in U.S. Patent No. 4,380,886 and up to eight (8) times the number of fully assembled toilets that are carried on a 53 foot standard truck trailer.

The differences between Applicant's invention and the prior art references cited by the Examiner in the rejection under 35 U.S.C. §103 are quite clear. The solutions taught by each of the references are directed to problems somewhat different than that described in Applicant's invention. For example, Dahl is directed to providing a light weight enclosure of the type which is simple and may be readily erected and also collapsed into a compact portable form by a single individual for transportation by automobile from one site to another. Tegg et al. is directed to problems associated with portable chemical toilet structures of the type, which are transported in an assembled condition thereby limiting the number of units, which may be transported by a carrier as set forth above. If, as the Examiner suggests, the teachings of Dahl are combined with the teachings of Tegg et al. in an attempt to obviate Applicant's invention, it is clear from the teachings set forth in Tegg et al. that the suggested combination would certainly not result in Applicant's invention for the simple reason that Tegg et al. suggests the use of multiple piece toilet shelters which are assembled on site while Dahl teaches the use of a readily collapsible eight layer stack and erectable compact portable units which may be erected by a single

individual for transporting in the trunk of a vehicle. Accordingly, the objects of each of the references are contrary to each other and therefore there is absolutely no implication, suggestion or inference whatsoever to combine the teachings of these two references in an attempt to obviate Applicant's invention without the guidance acquired from reading Applicant's disclosure. Further, although the Examiner alleges that Dahl suggests the claimed invention of Applicant's amended independent claims, except for a base and a roof, the Applicant respectfully disagrees with the allegations of the Examiner for the simple reason that there are significant structural differences between Applicant's invention and the teachings of Dahl's invention as a whole or the teachings of Tegg et al.'s invention as a whole, or any combination thereof. Both cited references as disclosed individually, fail to teach a final structure which, as taught, meets the objectives set forth by the inventor. Neither prior art teaches or suggest a loop enclosure collapsed to a final stackable flat transportable planar state having a thickness of about two of the walls thereof. Rather, the Dahl '256 patent teaches that the enclosure collapses to a final folded transportable flat state having a thickness of about eight of the walls thereof (Figure 4). Similarly the Dahl reference teaches the use of a double hinge 40, 55, which prevent the enclosure from having a folded planar transportable state, much less having a thickness of about two walls of the loop enclosure. The double hinge 40, 55 projects upwardly when the first fold of the complete eight layer fold process occurs and thus does not enable the enclosure to fold to a flat state having a thickness of about two of the walls thereof. This web 55 prevents adjacently stacked enclosures from being stacked flat atop one another. This is simply because the Dahl reference fails to teach an enclosure which is meant to fold flat to a thickness of about two walls thereof. Rather, Dahl teaches use of the double hinge 40, 55 to enable the Dahl enclosure to fold to a state

having a thickness of eight of the wall sections (Column 3, lines 1-3). Accordingly, it is clear that the Examiner's findings of suggestion to combine are unsupported by substantial evidence. In fact, Dahl teaches contrary or opposite of Applicant's teachings from the standpoint that the Dahl reference teaches a final transportable state resulting in a thickness of eight folds of all sections while Applicant's invention results in a final transportable thickness of two folded stackable loop enclosure. The teachings of Tegg et al. add absolutely nothing to the teachings of Dahl in order to, in anyway whatsoever suggest, imply, or infers to a person skilled in the art to teach Applicant's invention. In fact, in consideration of the Tegg et al. reference, which teaches away or opposite to Applicant's invention, it is clear that if any of the cited references teach away from the suggested combination, as set forth in the claims, the claimed invention is distinguishable over the combination of cited references (MPEP §2145). Further, it appears the Examiner overstated the knowledge of the skilled artisan and employed improper hindsight.

Use of Dahl's enclosure in Tegg's invention is contrary to Tegg's teachings in that Tegg teaches the easy replacement of individual pieces of the shelter should one become damaged. Further, the use of the floor and roof of Tegg's disclosure combined with the loop enclosure of Dahl may present some problems. For example, additional structure is necessary in order for the sidewall to be secured to a vertical wall as clearly illustrated in Figures 7-9 of Tegg et al. Also, the lower and upper edge of the vertical walls must be flared outwardly to accommodate the clips mounted on the base. This outward flare will cause a higher profile in a flat horizontal position which will result in being able to accommodate fewer stacked units on a standard 53 foot standard truck trailer.

Thus, even if the combination as suggested by the Examiner is somehow accomplishable, Applicant's claims set forth unobvious structural features over the proposed combination. Accordingly, the combination would necessary constitute claimed subject matter that is different and patentably distinct over the teachings of the combined prior art references.

One of ordinary skill in the art would have no basis for combining only the first step in Dahl's teachings and thereafter abandon the remainder of Dahl's teachings to acquire Applicant's invention. Without hindsight, what motivates the skilled artisan to abandon Dahl's teachings so that it may be combined with Tegg et al.'s teachings, because there is no suggestion, inference, or implication in this prior art to do so. It is well settled patent law that a sustainable obviousness rejection requires some teachings to combine the references in order to obviate Applicant's invention. Here, the Examiner fails to completely set forth any prima facie showing of obviousness since the Office Action does not identify prior art suggestions for the desirability for the proposed combination. The fact that both references disclose a portable toilet is not, by itself, sufficient to selectively substitute parts of one reference for part of another to meet Applicant's novel invention as claimed. Moreover, the Office Action does not set forth any principle with specific understanding within the level of ordinary skill in the art that would have motivated a skilled artisan to even attempt to combine these cited references as suggested by the Examiner. Applicant respectfully submits that the Office Action's lack of indication anywhere in the record of the finding in the cited references of substantial evidence to support the suggestion for the desirability for a person skilled in the prior art to proceed contrary to the teachings of Dahl, and in fact, completely disregard the eight layer folded unit as set forth in the disclosure of Dahl so as to attempt to create Applicant's invention as claimed.

Regardless of the lack of the proper suggestion in the Office Action, the cited references themselves contain no substantive evidence for combining the references that teach the invention as claimed according to Applicant's disclosure. In other words, there is nothing in either reference when considered alone or in combination that suggests the claimed invention as a solution to the problem of a final stackable, cost effective enclosure and, in fact, it is indeed only Applicant's invention, which creates a simple suggestion to solve such problem. Not a single applied reference mentions the economic problems associated with enclosures that are not optimized for stackability. Significantly, Applicant specifically identifies the four-wall thickness of the collapsed structure of his own earlier patent as a problem to be solved. The Dahl enclosure teaches a collapsed enclosure having a thickness of eight walls- four times as thick as that of the Applicant's current teachings. Therefore, absent the recognition of the problem identified by the Applicant, it would be impossible for its solution to be obvious to anyone, and the cited references cannot possibly suggest, singularly or in combination, a solution as novel as Applicant's invention. Nor would a skilled artisan abandon Dahl's teachings of a final transportable stack of eight thicknesses without any suggestion to do so by the prior art.

The undersigned also takes issue with the Examiner, as well as the Board's failure to give the phrase "for transporting said portable toilet shelter" any patentable significance. In the first place, this phrase is not in the preamble of the claim but in the body of the independent claim. This phrase recites an essential feature of the independent claim and is considered necessary to give meaning to the claim. The claim drafter chose the body of the claim to include this essential feature as opposed to reciting this phrase in the preamble to avoid the misinterpretation by the Board as well as the Examiner of this phrase. The body of a claim fully and intrinsically sets

forth the complete invention and must be given significance when these words are used in the body of a claim and not be dismissed as not being a limitation of the claim. In fact, every single word used in the body of a claim is a limitation of the invention claimed and therefore cannot summarily be neglected because the language is functional. Functional language breathes life into a claim. Further, the final structure of the invention is different than the prior art. Applicant does not rely only on intended use to distinguish the invention from the prior art but on fact that the claimed structure of the independent claims, when considered as a whole is structurally different than the structure disclosed in the Dahl reference.

Intended use language in the body of the claim is but a mere functional limitation which cannot be neglected as merely "intended use" language as would typically be found in preambles of claims. The claim drafter choose the body of the claim to define subject matter of the claim invention as is clearly supported by the specification and reflects the commercial advantages not earlier recognized by a person skilled in the art. This is because the prior art proposes an individual use for the invention while Applicant points out a commercial need previously unrecognized by the person skilled in the art. Even the invention in his previously granted U.S. Patent No. 4,380,836 did not recognize that the earlier disclosed invention created excessive transportation costs when supplying portable toilets to an event requiring hundreds of toilets. It was indeed a huge savings in transportation expenses by the use of a two-layer tier for stacking partially folded toilet shelters, as claimed. This cost savings was significant when the cost of transportation of previous prior art toilets such as Dahl as well as the disclosed bi-fold unit of the inventor's earlier patented toilet, U.S. Patent No. 4,380,836, is considered.

In view of a lack of showing by the Examiner of a clear factual basis to support a conclusion that the invention is obviated by the cited references in the Office Action, a person of ordinary skill in the art would not seek to combine these references cited in the Office Action to produce the results that Applicant's invention claims and teaches. It is only through Applicant's own teachings and disclosure that one of ordinary skill in the art would appreciate the need for a portable toilet shelter having a base, a loop enclosure circumscribing the base, wherein the loop enclosure is collapsible to a final stackable, folded state having a thickness of about two of the walls thereof. In other words, but for Applicant's disclosure, there is no teaching, suggestion, or inference whatsoever to combine the teachings of Dahl and the teachings of the Tegg et al. patent in any way in order to obviate Applicant's invention. Accordingly, Applicant respectfully asserts that the Office Action is an example of hindsight reconstruction in an attempt to obviate Applicant's invention after having the benefit of reading Applicant's disclosure. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the cited references to deprecate the claimed invention.

Applicant's invention is thus an unobvious improvement over the cited references and not an obvious modification or combination of any of the references of record in this application. When viewed singularly or collectively, none of the cited references disclose, teach, or even suggest a portable toilet shelter having a base, a loop enclosure circumscribing the base, and the loop enclosure being collapsible to a stackable folded state having a thickness of about two of the walls thereof. Thus, independent Claims 1, 7, 12, 17, and 21 are not rendered obvious by any of the cited references. Under principles of claim dependency and for at least the reasons stated above, Dahl and the Tegg et al. patents do not render obvious any of the dependent claims as

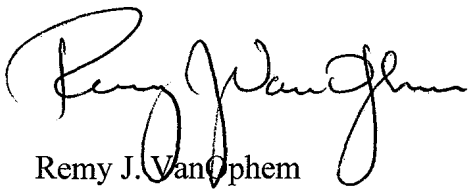
well. Therefore, reconsideration and withdrawal of the § 103 rejections are respectfully requested.

In view of the status of the file wrapper, every attempt has been made to place the claims in condition for allowance and it is respectfully asserted that there are no further issues, formal or substantive, that remain for prosecution. Formal allowance of the application is, therefore, respectfully solicited.

If the Examiner has any questions with respect to any matter now of record, Applicant's attorney may be reached at (586) 739-7445.

Respectfully submitted,

VANOPHEM &VANOPHEM, P.C.



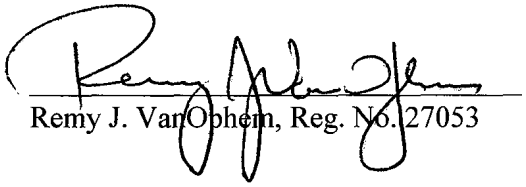
Remy J. VanOphem
Attorney for Applicant
Registration No. 27053

51543 Van Dyke Avenue
Shelby Township, MI 48316-4447
(586) 739-7445
vanpat@wowway.com
Attorney Docket No. NMC104A US
RVO/ndt

Certificate under 37 CFR §1.8(a)

I hereby certify that this Amendment under 37 C.F.R. § 1.111 and Request for Continued Examination is being electronically filed in the United States Patent Office using EFS-Web, on November 7, 2008.

Date: November 7, 2008



Remy J. VanOphem, Reg. No. 27053